

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT MITCHELL BLANKENSHIP
and
JAMES KEITH BARDMAN

Appeal No. 2003-0675
Application No. 09/789,388

ON BRIEF

Before PAK, WALTZ, and DELMENDO, Administrative Patent Judges.
DELMENDO, Administrative Patent Judge.

REMAND TO THE EXAMINER

We remand this application to the examiner for further action and consideration not inconsistent with our opinion below. 37 CFR §§ 1.196(a) and 1.193(b)(1) (1989, 2000).

As an attachment to a paper captioned "APPELLANT'S REPLY TO EXAMINER'S ANSWER" (filed Nov. 6, 2002, paper 14), the appellants submitted new evidence in the form of "Fillers," in
10 Kirk-Othmer Encyclopedia of Chemical Technology 745, 748, 761

(4th ed., New York, John Wiley & Sons, Inc. 1992). Concerning the appellants' overall submission, the examiner stated: "The reply brief filed 11/6/02 has been entered and considered. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal." (Communication mailed Jan. 22, 2003, paper 15.) The examiner, however, did not comment on whether the newly submitted evidence has been entered and considered.

37 CFR § 1.195 states: "Affidavits, declarations, or exhibits submitted after the case has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented." In addition, MPEP § 1208.03 (Aug. 2001) explains:

Amendments, affidavits, and/or other evidence must be submitted in papers separate from the reply brief, and the entry of such papers is subject to the provisions of 37 CFR 1.116 and 37 CFR 1.195. A paper that contains an amendment (or evidence) is not a reply brief within the meaning of 37 CFR 1.193(b). Such a paper will not be entitled to entry simply because it is characterized as a reply brief.

It is clear, therefore, that the examiner's failure to comment on the newly submitted evidence is not in accordance with current patent practice and procedure. To correct this deficiency, the examiner must clarify whether the submission of the evidence complies with the provisions of 37 CFR § 1.195

(1969) and, if so, clearly indicate whether the evidence has been entered and considered.

The examiner must also prepare a supplemental examiner's answer pursuant to 37 CFR § 1.193(b)(1) responding to each argument set forth in the reply brief.

In the supplemental examiner's answer, the examiner is required to provide a detailed discussion on how appealed claim 9 is being interpreted. Specifically, the examiner must indicate whether the conditional properties recited in the claim are listed alternatively or conjunctively.¹ If the conditional properties are listed alternatively, the examiner is required to analyze whether the properties are applicable only when one of the conditions with respect to particle size is met.² For example, the examiner should answer whether the claim

¹ The conditional properties are:

less than 0.77 g/cc when the swollen multi-stage emulsion polymer has a particle size below 275 nm; less than 0.74 g/cc when the swollen multi-stage emulsion polymer has a particle size of from 275 to 500 nm; less than 0.59 g/cc when the swollen multi-stage emulsion polymer has a particle size of from 501 to 750 nm; less than 0.46 g/cc when the swollen multi-stage emulsion polymer has a particle size of from 751 to 1300 nm.

² We note that the recited particle sizes are average particle sizes. (Specification, p. 28, ll. 14-15.)

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encompasses an aqueous polymer emulsion comprising swollen multi-stage emulsion polymer having an average particle size greater than 1300 nm and, if so, whether the swollen multi-stage emulsion polymers must meet certain dry bulk density requirements.

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This application, by virtue of its "special" status, requires an immediate action. See MPEP § 708.01(D) (8th ed., Rev. 1, Feb. 2003). Thus, it is important that the Board be promptly informed of any action affecting the appeal in this case.

REMANDED

Chung K. Pak)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
Thomas A. Waltz)	
Administrative Patent Judge)	APPEALS AND
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Romulo H. Delmendo)	
Administrative Patent Judge)	

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